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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,897	05/25/2001	Takashi Mine	7806/82810	5339
24628	7590	11/03/2004	EXAMINER	
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			HOOSAIN, ALLAN	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/865,897

Applicant(s)

MINE, TAKASHI

Examiner

Allan Hoosain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show a legend identifying and describing the labels as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawing corrections are not satisfactory. For example with respect to Figure 1, there are no labels for elements 21 and 11-14. In addition, labels are required for the elements on Figures 2 and 5.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 11 recites the limitation "the toll fee" in line 11. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 9 recites the limitation "the server" in line 3. There is insufficient antecedent basis for this limitation in the claim.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not pointed out where the amended claim is supported, nor does there appear to be a written description of the claim limitation "telephonic code" in the application as filed.

7. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not pointed out where the amended claim is supported, nor does there appear to be a written description of the claim limitation "telephonic data" in the application as filed.

8. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not pointed out where the amended claim is supported, nor does there appear to be

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a written description of the claim limitation "targeted phone number data code" in the application as filed.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by **Beach et al.** (US 6,084,528).

As to Claim 1, with respect to Figures 5 and 7, **Beach** teaches a digital information input system comprising:

an electronic information terminal device for inputting links (code information) regarding a product (search targeted article or the like) and for sending data including the code information (Figure 7E and Col. 11, lines 39);

the data comprising a telephonic code having at least one encoded symbol, the at least one encoded symbol causing the device to differentiate a dialed telephone number from data (Col. 10, lines 15-28 and Col. 2, lines 53-58); and

a server for returning, to the digital information terminal device, digital information corresponding to the telephone code information based on the data transmitted from the electronic information terminal device (Col. 10, lines 15-28);

wherein the electronic information terminal device sends the data including the code information regarding the search targeted article and allows use of the digital information transmitted from the server after the telephonic code information regarding the search targeted article is inputted (Col. 10, lines 15-28).

As to Claim 2, **Beach** teaches the digital information input system according to claim 1, wherein the electronic information terminal device has a short range radio link (an infrared reading portion) and serves a portable information terminal device for inputting and reading code information via the infrared reading portion (Col. 4, lines 43-45).

As to Claim 5, **Beach** teaches the digital information input system according to claim 1, wherein the electronic information terminal device has at least one of the following functions:

displaying and saving the digital information returned from the server as a file;

playing and saving the digital information as a file; or

providing information on an electronic information web by using a link of the digital information (Figure 7e and Col. 11, lines 32-43).

As to Claim 6, **Beach** teaches the digital information input system according to claim 1, wherein the digital information includes URL (Col. 11, lines 32-43).

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As to Claim 3, with respect to Figure 8, **Beach** teaches a digital information input system comprising:

an electronic information terminal device capable of sending data including a link (search targeted phone number data code and at least one encoded symbol) (Col. 10, lines 15-28 and Col. 2, lines 53-58); and

a server for returning, to the digital information terminal device, a digital information corresponding to the link (search targeted phone number data code) included in the data transmitted from the electronic information terminal device (Col. 10, lines 15-28);

wherein the electronic information terminal device sends the data including the phone number datacode regarding the search targeted article and enables use of the digital information sent from the server (Col. 10, lines 15-28).

As to Claim 4, **Beach** teaches the digital information input system according to claim 3, wherein the electronic information terminal device is a portable information terminal device capable of entering dial numbers (Figure 8, label 301 and Col. 10, lines 15-28).

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. Claims 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by **Parsons** (US 4,486,853).

As to Claims 7-8, with respect to Figures 2 and 6, **Parsons** teaches an encoded card (digital information input system) applying digital information to a bar code (an article) by using only a readable transparent ink,

wherein the transparent ink is read by a card reader (transparent ink readable reading device) loaded or connected to a receiver/display device (an electronic information terminal device) for reading digital information in a form of the transparent ink so as to obtain information regarding the bar code (article) and transmitting the information back to the receiver/display device (digital information input system) (Figures 2,4,6 and Col. 18, lines 10-47).

12. Claims 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by **Miller** (US 4,889,367).

As to Claims 7-8, with respect to Figures 1-3, **Miller** teaches a multi-readable information system (digital information input system) applying digital information to machine-readable symbology (an article) by using only a readable transparent ink,

wherein the transparent ink is read by an infrared wavelength reader (transparent ink readable reading device) loaded or connected to a bar-code reading machine (an electronic information terminal device) for reading digital information in a form of the transparent ink so as



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to obtain information regarding the machine-readable symbology (article) and transmitting the information back to the bar-code reading machine (digital information input system) (Col. 3, lines 5-12,36-62).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Beach** in view of **Miller**.

As to Claims 7-8, with respect to Figures 1 and 5,7, **Beach** teaches a barcode 122 (digital information input system) applying digital information to a product (an article) by using only a recognizable code (readable transparent ink),

wherein the recognizable code (transparent ink) is read by a barcode reader (transparent ink readable reading device) loaded or connected to a terminal (an electronic information terminal device) for reading digital information in a form of the recognizable code (transparent ink) so as to obtain information regarding the product (article) and transmitting the information back to the terminal (digital information input system) (Col. 8, lines 1-21);

**Beach** does not teach the following limitation:

“readable transparent ink”

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However, it is obvious that **Beach** suggests the limitation. This is because **Beach** teaches any type of machine code reader could be used (Col. 3, lines 26-33). **Miller** teaches infrared barcodes (readable transparent ink) and bar code-reading machines (Col. 3, lines 5-12). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add infrared capability to **Beach's** invention for encoding labels as taught by **Miller's** invention in order to provide scanners with infrared machine code readers.

As to Claim 9, **Beach** teaches the digital information input system according to claim 8, wherein the electronic information terminal device has at least one of the following functions:

- displaying and saving the digital information returned from the server as a file;
- playing and saving the digital information as a file; or
- providing information on an electronic information web by using a link of the digital information (Figure 7e and Col. 11, lines 32-43).

As to Claim 10, **Beach** teaches the digital information input system according to claim 8, wherein the digital information includes URL (Col. 11, lines 32-43).

#### ***Response to Arguments***

15. Applicant's arguments filed in the 6/25/04 Remarks have been fully considered but they are not persuasive because of the following:

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The argument that **Beach** does not use telephone communication for conveying digital data is not persuasive as indicated in the rejections of the claims in the instant Office Action.

The argument with respect to **Sasunuma** is moot in view of the new grounds of rejections.

Examiner respectfully invites Applicants to contact Examiner to discuss possible amendments for overcoming the prior art of record.

### *Conclusion*

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Cyr et al.** (US 6,138,913) teach an image reading device which detects invisible ink using infrared systems.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any response to this final action should be mailed to:

**Box AF**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications; please mark "EXPEDITED  
PROCEDURE")

**Or:**

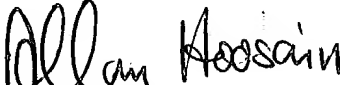
(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121  
Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The  
examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
**Allan Hoosain**  
**Primary Examiner**  
**10/20/04**